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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,259	07/24/2003	Zhong Ding	961_013NP	9582
72742	7590	02/25/2008		
Hiscock & Barclay, LLP One Park Place 300 South State Street Syracuse, NY 13202-2078			EXAMINER GORDON, BRIAN R	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			02/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/626,259

Applicant(s)

DING ET AL.

Examiner

Brian R. Gordon

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-28-08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,9 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,9 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1448 or PTO-889)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 28, 2008 has been entered.

Response to Arguments

2. Applicant's arguments filed January 28, 2008 have been fully considered but they are not persuasive. Applicant asserts "it is not believed that the cap of Hughes describes or suggests an optical read window as intended by the present invention. To that end and according to the present invention, a quantity of fluid must be present within the metering tip itself to permit spectrophotometric optical analysis. The read window must permit such detection meaning that: i) the fluid should be contained within the element itself and ii) in a section that permits optical detection without distortion." As previously stated applicant "optical read window" is not structurally distinguished from any other portion of the wall of the tip. The entire tip is made of the same transparent material. Applicant has elected to refer to a portion of the wall as an "optical read window". Any portion of the wall can be referenced as such. Furthermore the remarks directed to the permission of spectrophotometric analysis is directed to how the device is intended to be used. Furthermore the argument is not commensurate in scope

with the claim. The only requirement is the device be comprised of material that allows for some type of optical analysis (including manual viewing with the human eye or other instrumental optical analysis). The is argument is also further not commensurate in scope with that of the claims for there are no limitations placed on the level of optical analysis as suggested by the phrase "without distortion". Applicant has amended the claim to recite a metering tip **to aspirate and dispense a quantity of liquid**. The liquid is not claimed as a portion of the structure of the tip. The phrases recited above and the further amended phrases are directed to how one intends to use the device with a fluid. The additional phrase of claim 6 directed to the draw back of the dead volume is directed to what is intended to happen during use of the device rather than structural elements that define the tip. As previously stated a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (see also the explanation provided in the prior Final Office Action). The device can be used in any manner one chooses. A large portion of the claim is directed to what is intended to occur or happen (latching, reduction in oscillation, oscillation due to air, dead volume draw back, etc.) in the event if one chooses to aspirate or dispense a fluid. If one chooses not to do either the structure would remain the same. The additional amended phrase directed to what causes oscillation. The phrases are moreso to the affects that occur during a method of use of the device rather than the structure of the device. Applicant asserts the figures support the recitation of the window being planar and of substantially constant diameter. The invention Hughes like the

instant invention includes step portions defined by a horizontal wall and vertical. The vertical portions are have a constant planar interior diameter for the length each extends to and meets the next adjacent horizontal wall portion.

In view of the remarks of above and those of the previous Office Action the claims are rejected as given herein.

In view of applicant's arguments the previous art rejections of claims 9 and 12-17 are hereby withdrawn.

Drawings

3. The drawings were received on July 12, 2007 wings are acceptable

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9 and 12-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While claim 9 was in the originally filed application, it has been amended to incorporate steps that were not previously claimed. Claims 12-17 were not originally filed in the application.

Claim 16 suggests a method comprising the steps of aspirating a first a fluid volume from a source, dispensing portions of said first volume to one reaction device, and subsequently aspirating the remaining portions of the first fluid volume into the tip. How can one aspirate the remaining portions of the initial fluid when the previous step already establishes the initial volume has already been aspirated? Where is there support for such a method? There is no antecedent basis for "the remaining volume of fluid in claim 16". Claim 13 does not state that there is remaining fluid after the dispensing step. Where is the remaining fluid?

It is hereby requested applicant state where each of the steps incorporated the claims are supported in the original specification to ensure new matter has not been incorporated in the claims.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes US 3,449,081.

Hughes discloses a tapered, plastic cap (tip) that includes upper and lower openings and stepped portions therein (see Figures 4 and 6). As given herein above, the examiner asserts the device of Hughes is equivalent to the claimed structure.

While Hughes specifies the cap is plastic (column 3, line 52), it is not specifically recited that the plastic material is transparent or clear. However, it should be noted that the reference does not state the cap is not clear or transparent as asserted by applicant.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the plastic material of the cap maybe transparent. It is conventionally known that plastic materials maybe transparent. For example, as admitted by applicant the syringe and bottle of Hughes is manufactured from a clear, plastic material (column 3, line 6)

As to claim 9, the cap is attached to a bottle (metering apparatus) fluid is aspirated and dispensed from such cap. Since the cap is structurally equivalent the affects of such structure on moving fluid as recited would be inherent.

8. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukacs et al., US 3,780,935 and Treptow et al.

Lukacs et al. discloses all of the claimed structural limitations (see figure 6) except for a read window.

Treptow et al. disclose an apparatus for pipetting and photometrically evaluating samples through a window.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the dispensing device of Lukacs et al to incorporate the optical windows as taught by Treptow in order to provide a cap of test kit to allow for "on-the-spot"-analytics of the samples.

It would have further been obvious to recognize the device maybe manufactured from conventional transparent material such as glass or plastic thereby establishing a read window.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
Art Unit 1797

brg